

Appln. No. 09/826,690  
Reply to Office Action dated July 27, 2006

Docket No. 6994-1

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**REMARKS**

In response to the Office Action dated July 27, 2006 (hereinafter "Office Action"), Applicant filed an RCE with a three month suspension of prosecution on January 29, 2007, and now files this Amendment. Applicant respectfully requests withdrawal of the rejections in light of the new claims and the following remarks. By this Amendment, claims 1-22 are cancelled and new claims 23-44 are presented. No new matter has been added.

**Support for Claim Amendments**

New claims 23, 43 & 44 are specifically drawn to standardized test takers who possess a GPA and standardized test score (hereinafter "numerical credentials") that are insufficient to gain regular admission to a graduate school and who did not initially apply to the graduate school. Support for the insufficient GPA and standardized test score can be found throughout the specification, including p. 3, end of first full paragraph; p. 3-4, discussion of candidates with numerical credentials falling below a minimum criteria; p. 11, second and third full paragraphs; p. 13, first two paragraphs, including the shifting range. The did not initially apply limitation was already present in the claims.

Support for new claim 25 can be found throughout the specification, including p. 17, first full paragraph. Support for new claims 26 & 27 can be found throughout the specification, including the paragraph bridging pages 11 & 12. Support for new claims 40 & 41 can be found throughout the specification, including p. 13.

No new matter is added by the current Amendment.

**Claim Rejections Under 35 U.S.C. §112, paragraph 1**

The rejection under 35 U.S.C. §112, first paragraph is moot since the rejected language is not present in the pending claims.

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**Claim Rejections Under 35 U.S.C. §102**

In the Office Action, multiple claims stood rejected under 35 U.S.C. § 102(b) as being anticipated by www.gradcollege.swt.edu (hereafter "Grad College"). The Applicant respectfully submits that Grad College does not anticipate the method of the claimed invention.

In order to properly address the Grad College reference, Applicant will first review the state of the graduate school admission process and conditional admissions, including Grad College, prior to the claimed invention.

The regular and conditional admissions decisions of graduate schools are based on numerous factors including undergraduate GPA, standardized test scores, resumes, letters of recommendation, personal statements, etc.. Conditional admissions decisions are the exception rather than the rule. Where available, conditional admissions decisions are made for *individual applicants for admission* whose numerical credentials are insufficient for admission, but who exhibit some evidence demonstrating the individual applicant may be successful at the graduate school. The evidence demonstrating the potential for success is either (i) communicated by a faculty sponsor who recommends the applicant for conditional admissions, or (ii) found in information submitted as part of the formal application, for example, the resume, letters of recommendation, personal statements, etc. (hereinafter "Subjective Supplementary Materials").

Students that are conditionally admitted to a graduate school enroll in the same regular length, for-credit classes taken by regularly admitted students. Prior to the claimed invention it would have been unthinkable for graduate schools to ask conditionally or regularly admitted students to take these classes without receiving credit.

When an individual takes a standardized test for graduate admissions the test taker is asked to provide demographic information, such as, type of degree desired, desired area of study, undergraduate GPA, desired geographic location of graduate school, gender and ethnicity. It is known in the admissions industry for graduate schools to screen test takers for those (i) who meet the graduate school's requirements for GPA and standardized test score, and (ii) may be interested in the graduate school's graduate program. The screening process offered by standardized test administrators is limited to the undergraduate GPA, standardized test score and the demographic information provided by the test taker. Prior to the claimed invention, the test

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takers identified by the screening process were invited to file an application with the graduate school. Once the graduate school received the completed application, the application, including the Subjective Supplementary Materials, was analyzed and the graduate school made an admissions determination.

Although admissions decisions are important, graduate school administrators desire to minimize the amount of time faculty members on the admissions committee are required to dedicate to admissions decisions in order to maximize the amount of time spent on research, publications and teaching. Thus, it was and is contrary to the knowledge of one skilled in the art of graduate school admissions to create an admissions process longer and more complex for the graduate school to administer.

Traditionally, when a graduate school desires to increase enrollment, it lowers its admission standards (minimum acceptable numerical credentials), solicits applicants that meet the admissions standards of the graduate school, or both. If the admissions standards are reduced, the admissions committee will evaluate the applications using the new admissions standards. If the admissions standards remain the same, the graduate school hopes the solicitations result in a larger pool of applicants who meet the admissions standards. Because graduate schools endeavor to streamline the admissions process, it is contrary to the knowledge of one skilled in the art to intentionally solicit applicants who possess numerical credentials below the admissions standards of the graduate school. Thus, the claimed element of intentionally soliciting applications from test takers who have numerical credentials falling below the admissions standards is completely unknown in graduate school admissions. This was previously confirmed in the affidavit of Philip D. Shelton, CEO of the LSAC.

We now turn to the claimed invention as set forth in new claim 23, which recites:

23. (New) A method for admission to a graduate school, said method comprising the steps of:

- identifying a pool of standardized test takers who possess a GPA and standardized test score that are insufficient to gain regular admission to a graduate school and who did not initially apply to the graduate school, wherein the identifying step is enabled by a computer product;

- offering a program for admission to the graduate school to the identified test takers, wherein the program for admission includes an abbreviated academic program;

- providing instruction in at least one academic discipline to each of the test takers who accept the offer to participate in the program for admissions;

- subjecting test takers in the program for admission to at least one examination during the abbreviated academic program, each test taker in the program for admissions achieving a score

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on the at least one examination, wherein each score is assigned using a calibrated grading process; and

admitting into the graduate school those test takers who achieve a score on said at least one examination which exceeds a pre-determined score deemed to correlate with academic success at the graduate school.

Grad College does not disclose or suggest the claimed method because Grad College fails to disclose or suggest at least the following elements of claim 23: (i) offering participation in a program for admission to test takers who have not applied for admission, (ii) offering participation in a program for admission to test takers who have not applied for admission and who possess GPAs and standardized test scores that are insufficient to gain regular admission to the graduate school, (iii) calibrated grading of examinations, (iv) offering a program for admission consisting of an abbreviated academic program that the test takers may participate in without a personal recommendation from a graduate advisor, or (v) any combination of these elements.

The present invention is drawn to a method of admissions where a computer product is used to identify a pool of standardized test takers who did not initially apply to the graduate school and who possess a GPA and standardized test score that are insufficient to gain regular admission to a graduate school. Because the identification step is conducted before the test takers file an application for admission, the identified standardized test takers are offered the opportunity to participate in a program for admission to the graduate school without regard for their Subjective Supplementary Materials or any other subjective information about the test takers. Thus, the only hurdles to admission for a standardized test taker identified by the claimed process are (A) accepting the offer to participate in the program for admissions, and (B) achieving the pre-determined score.

In contrast to any cited reference, the identified test takers are not solicited to file an application for admission, rather they receive an offer to participate in the program for admission that they may accept without further consideration by the admissions committee. Also in contrast to any cited reference, the standardized test takers who accept the offer to participate in the admissions program are automatically admitted to the graduate school if they achieve a pre-determined score on the one or more examinations administered during the program for

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admissions. None of these elements are disclosed or suggested by Grad College or any other cited reference.

The relevant portion of Grad College, p. 7, paragraph beginning "Conditional Admission," states:

**Conditional Admission.** The graduate advisor in the degree program which you seek to enter may recommend to the dean of the Graduate College that you be "conditionally" admitted even though you may or may not meet the minimum requirements for admission. This recommendation is based on evidence that you can successfully pursue graduate study and is governed by the stated admission policies in your proposed program.

In contrast to the claimed invention, conditional admissions decisions in Grad College are restricted to applicants for admission who receive a recommendation from a graduate advisor in the relevant degree program based on the graduate advisor's subjective belief that the applicant will succeed if admitted, *see id.* In fact, conditional admission decisions as set forth in Grad College are only available where a test taker (a) files an application, (b) seeks out the graduate advisor of the desired degree program, and (c) convinces the relevant graduate advisor to recommend conditional admission based on some evidence the test taker can succeed in the graduate program. These steps all require personal assessments during the identification steps and cannot be achieved using a computer as in the claimed invention. Neither Grad College, nor any cited reference, nor the knowledge of ones skilled in the art, disclose or suggest the claimed invention where a program for admission is offered to a pool of non-applicants who possess numerical credentials that fall below the admissions standards of the graduate school. Accordingly, Applicant believes that claim 23 and all claims dependent thereon are drawn to allowable subject matter.

### **Claim Rejections Under 35 U.S.C. §103**

In the Office Action, multiple claims stood rejected under 35 U.S.C. § 103(a) as being unpatentable over [www.gradcollege.swt.edu](http://www.gradcollege.swt.edu) in further view of KAREN W. ARENSON, "Opponents of a Change in CUNY Admissions Policy Helped Pass a Compromise Plan," N.Y.TIMES (November 24, 1999) (hereinafter "Arenson"), and various other references. Applicant

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respectfully submits that no combination of Grad College with the cited reference discloses or suggests the method of the claimed invention.

A *prima facie* case of obviousness requires (1) a motivation or suggestion to combine the teachings of the references, (2) a reasonable expectation of success, and (3) that the prior art references or knowledge of one skilled in the art must teach or suggest all the claim limitations. See MPEP §2143. An obviousness rejection cannot be sustained if any of these elements is not established or the applicant can rebut any of the elements. As discussed above, Grad College does not disclose or suggest: (i) offering a program for admission to test takers who have not applied for admission, (ii) offering a program for admission to test takers who have not applied for admission and who possess GPAs and standardized test scores that are insufficient to gain regular admission to the graduate school, (iii) calibrated grading of examinations, (iv) offering a program for admission consisting of an abbreviated academic program that the test takers may participate in without a personal recommendation from a graduate advisor, or (v) any combination of these elements. In fact, none of the cited art teaches or suggests these elements of the present claims. Accordingly, Applicant believes that all claims are drawn to allowable subject matter.

Arenson indicates that CUNY's undergraduate program offers some CUNY applicants an opportunity to take remedial classes in order to improve their scores on an admissions test. Arenson does not disclose or suggest seeking out non-applicants with numerical credentials that are insufficient to gain regular admission to a graduate school. In addition, Arenson deals with undergraduate education, not graduate education. Some people of ordinary skill in the art believe that students are entitled to an undergraduate education, even if remedial classes are necessary to prepare the individual for undergraduate classes. This is generally justified as a necessary correction of the school system's failure to address the needs of these individuals who are unprepared for an undergraduate education. However, this belief and justification does not extend to graduate education. *Administrators of graduate schools require that test takers possess certain skills and knowledge prior to admitting them to the graduate school.*

In contrast to the remedial program disclosed in Arenson, Applicant Harbaugh's claimed method of admissions assists admissions officers to identify those test takers who possess insufficient numerical credentials, but possess the necessary knowledge and skills to succeed in

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graduate school. This is a significant distinction that is neither disclosed nor suggested by Arenson or any other cited references.

Additionally, there is no motivation, suggestion or teaching in the cited references or the knowledge of one having ordinary skill in the art to combine references to reach the claimed invention. Grad College provides for conditional admission decisions at Southwest Texas State University for applicants who do not meet the GPA and Graduate Record Exam (GRE) requirements only if the graduate advisor in the degree program which the applicant seeks to enter identifies specific evidence that the applicant can successfully pursue graduate study, see Grad College, p. 7.

Conditional admissions decisions made using the Grad College reference are limited to individual test takers and are only available where the test taker (a) files an application, (b) seeks out the graduate advisor of the desired degree program, and (c) convinces the relevant graduate advisor to recommend conditional admission based on some evidence the test taker can succeed in the graduate program. Grad College does not provide any motivation or suggestion to solicit applications from non-applicants with numerical credentials that do not meet the admissions requirements. Grad College does not provide any motivation or suggestion to offer a program for admission where test takers possessing inadequate numerical credentials are automatically enrolled if they achieve a pre-determined score on an examination or examinations administered during the program for admission. Finally, Grad College clearly does not provide any motivation, suggestion or teaching for a combination of these two claimed elements.

As noted above, the knowledge of one of ordinary skill in the art leads graduate schools to request the names of test takers whose GPA and standardized test score meet or exceed the admissions requirements of the graduate school. These individuals are invited to apply for admission to the graduate school. Thus, the knowledge in the art provides no motivation or suggestion to (1) identify a group of test takers who possess numerical credentials that do not meet a graduate school's admission requirements, or (2) to invite this group of test takers to participate in the claimed program for admissions, where each test taker that accepts the invitation is allowed the opportunity to be admitted to the graduate school without the need for conventional application for admission or a recommendation from a graduate advisor.

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The "Response to Arguments" section of the withdrawn Office Action mailed March 8, 2007 (hereinafter "Withdrawn Office Action") states that how and what an institution searches is not novel and that "universities have been conducting searches for potential enrollees in all different categories of academics and programs," Withdrawn Office Action, p. 9-10. Applicant strongly disagrees with these assertions. The Examiner's statement about searches is extremely broad and the record is completely devoid of any documentary evidence that supports the statement. In contrast, Applicant submitted a sworn statement from a prominent expert, Mr. Phillip D. Shelton, that directly contradicts the Examiner's assertions.

It appears that the Examiner is attempting to rely on official notice in an attempt to overcome the sworn testimony of Mr. Philip D. Shelton. The MPEP notes that "Official notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art, are *capable of instant and unquestionable demonstration as being well-known*," MPEP 2144.03, p. 2100-134 (emphasis added). Such facts must be "*capable of such instant and unquestionable demonstration as to defy dispute*." See *id.* Finally, the MPEP requires that where official notice is traversed, "the examiner must provide documentary evidence in the next Office action if the rejection is to be maintained," MPEP 2144.03.C.

Applicant respectfully traverses any assertion that graduate schools conduct searches for test takers with a standardized test score and an undergraduate GPA that are insufficient to gain regular admission to graduate schools. Applicant's position is supported by the sworn statements of Philip D. Shelton, CEO of the Law School Admissions Counsel (LSAC). Over the past thirty-two years, Affiant Philip D. Shelton has been continuously and intimately involved in graduate school admissions as a law school dean, as a senior member of LSAC, and now as CEO of LSAC. In his positions as law school dean and CEO of the LSAC, Mr. Shelton has been in constant contact with law school deans and administrators who are (a) searching for the names of potential admissions candidates and (b) experimenting with new ways to make admissions decisions. In Mr. Shelton's extensive experience, he unequivocally states that Applicant Harbaugh is the only graduate school administrator he has known or heard of that has ever requested names of students with GPAs and standardized test scores clearly outside the range of



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those acceptable to the requesting graduate school, *see* Affidavit of Philip D. Shelton, paragraph 7.

Applicant respectfully asserts that Mr. Shelton can be considered nothing less than a prominent expert in the relevant art. The Withdrawn Office Action attempts to take official notice of something that Mr. Shelton expressly stated was unknown to him. Clearly, these facts are not "capable of instant and unquestionable demonstration as being well-known" and do not meet the requirements set forth for official notice under MPEP 2144.03. Accordingly, the MPEP requires that the Examiner provide documentary evidence in the next Office action if the rejection is to be maintained on this ground, *see* MPEP 2144.03.C.

Clearly, the cited references do not disclose or suggest each element of the claimed invention. Clearly, neither the cited references nor the knowledge of one skilled in the art provide any motivation or suggestion to combine Grad College, or any other cited reference, with other references to create the claimed method of admission. Accordingly, Applicant believes that all claims are drawn to allowable subject matter.

#### Secondary Considerations

With respect to the pending claims, and claim 44 in particular, Applicant respectfully requests that the Examiner consider secondary considerations, such as the failure of others and long-felt but unresolved needs, as indicia of nonobviousness, *see* MPEP §716.01(a). Philip D. Shelton, President of the LSAC, the group that administers the LSAT, states that the LSAT is the best standardized admission test in the admission testing industry. *See* Affidavit of Philip D. Shelton. The score a test taker achieves on the LSAT, while representing a bell curve centered on that value, is indicative of the most likely level of performance in law school. Thus, like all bell curves, a significant percentage of test takers with a given score will perform better than the mode, *i.e.* the performance level of the test taker with a given score having the average performance level in law school.

Mr. Shelton states that *even after extensive research*, the LSAC has been unable to identify a single variable or combination of variables that will identify test takers who will

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significantly outperform test takers with much higher scores. *See* Affidavit of Philip D. Shelton, paragraph 4. Mr. Shelton goes on to state:

The claimed methods [of the present invention] are more effective at identifying students with a lower LSAT score who perform at the high end of the bell curve more effectively than any other admissions method of which I am aware. In short, the AAMPLE<sup>®</sup> program incorporating the claimed methods presents a method that has proven successful for identifying "diamonds in the rough" who will perform well at law school despite a relatively low LSAT score.

*See* Affidavit of Philip D. Shelton, paragraph 6.

As noted above, the LSAT is the best standardized admissions test in the industry. Thus, if the LSAT cannot identify high-performing, low-scoring test takers, neither can the MCAT, DAT, VCAT, PCAT, AHPAT, GRE, or the GMAT. In fact, the need for the method of the present claims would be even greater for these other admissions tests.

In response to the above secondary considerations, the Office Action asserted that Applicant has not shown that the claimed invention has successfully identified students who will perform better than higher test scorers in an actual law program, *see* Office Action, paragraph 30. This challenge to the secondary consideration was not present in the Withdrawn Office Action. Accordingly, Applicant believes that the arguments submitted in the Reply dated October 24, 2006 overcame the challenge. In either case, Applicant reasserts these arguments found on pages 14 through 16 of the Reply filed October 24, 2006.

Even if the cited references did meet the elements of a prima facie case of obviousness, which they do not, Applicant believes that these secondary considerations would overcome the prima facie case of obviousness. Accordingly, Applicant respectfully requests allowance of all pending claims.

### Conclusion

For at least the reasons given above, Applicant respectfully submit that the claims *clearly* define over the prior art. Applicant further respectfully submit that each of the dependent claims define over the prior art as they each depend from one of the independent claims while reciting

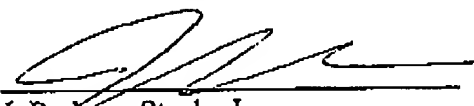
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additional distinguishing features. Accordingly, Applicant respectfully request early and favorable consideration of the claims.

Should the Examiner believe that anything further is necessary in order to place the application in better condition for allowance, the Examiner is respectfully requested to contact Greg Lefkowitz at 561-671-3624. No additional fees are believed due; however, the Commissioner is hereby authorized to charge any deficiency, or credit any overpayment, to Deposit Account No. 50-0951.

Respectfully submitted,

Date: April 30, 2007

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